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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,285	06/24/2003	Michael E. Shanahan	MES/002CONII	4408

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EXAMINER

NGUYEN, TUAN HOANG

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,285

Applicant(s)

SHANAHAN, MICHAEL E.

Examiner

Tuan H. Nguyen

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 6/24/2003, 9/3/2003, 3/2/2004, and 5/19/2005 has been considered by Examiner and made of record in the application file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 3, 5-10, 12, 14-19, 21-22, and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Galensky et al. (US PAT. 6,845,398 hereinafter, "Galensky").

Consider claims 3, 12 and 21, Galensky teaches for providing a video file to a wireless telephone, the system comprising: a remote computer with access to a database of video files suitable for downloading to the wireless telephone (col. 7 lines 25-42) wherein the remote computer is configured to: provide a list of video files in the database to a user of the wireless telephone when the user requests the list of video files (col. 1 lines 20-31); allow the user of the wireless telephone to browse the list of video files (col. 4 line 66 through col. 5 line 9); allow the user of the wireless telephone to select a desired video file from the list of video files (col. 5 lines 31-36); and allow the user of the wireless telephone to optionally download a selected video file into the wireless telephone for use as desired by the user of the wireless telephone (col. 4 lines 42-48); wherein the system is configured to confirm the selected video file has been properly received by the wireless telephone (col. 6 line 59 through col. 7 line 10).

Consider claims 5, 14 and 24, Galensky further teaches configured to allow the user of the wireless telephone to review the selected video file before downloading the

selected video file into a programmable memory in the wireless telephone (col. 4 lines 42-48).

Consider claims 6, 15, and 25, Galensky further teaches configured to provide the user of the wireless telephone with the option of downloading the selected video file into a programmable memory in the wireless telephone after reviewing the selected video file (col. 7 lines 25-42).

Consider claims 7 and 16, Galensky further teaches configured to provide the user of the wireless telephone with the option of editing the selected video file before programming the selected video file into the programmable memory in the wireless telephone (col. 3 lines 52-63).

Consider claims 8, 17, and 26, Galensky further teaches the remote computer is further configured to provide a plurality of lists of video files for browsing by the user of the wireless telephone (col. 4 line 66 through col. 5 line 9).

Consider claims 9, 18, and 27, Galensky further teaches the database is configured to include video files in a format selected from the group comprising MPEG, JPEG, AVI, or DVD format (col. 1 lines 19-27).

Consider claims 10, 19, and 28, Galensky further teaches configured to provide copyright protection for the database of video files to help prevent unauthorized distribution of video files downloaded by the user of the wireless telephone (col. 6 lines 45-58).

Consider claim 22, Galensky further teaches configured to operate in conjunction with a distribution computer to confirm the selected video file has been properly received by the wireless telephone (col. 6 line 59 through col. 7 line 10).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 13, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky et al. (US PAT. 6,845,398 hereinafter, "Galensky") in view of Goodman (U.S PAT. 5,694,455).

Consider claims 4, 13, and 23, Galensky teaches a system for providing a video file to a wireless telephone.

Galensky does not explicitly show that the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information.

In the same field of endeavor, Goodman teaches the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information (col. 1 lines 39-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, the remote computer is further configured to allow the user of the wireless telephone to search the database of video files for a certain video file using title or description information, as taught by Goodman, in order to provide audio data or programs to users which typically receive or listen to in a moveable or transient manner.

7. Claims 11, 20, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky et al. (US PAT. 6,845,398 hereinafter, "Galensky") in view of Abraham et al. (U.S PAT. 5,694,455 hereinafter, "Abraham").

Consider claims 11, 20, and 29, Galensky teaches a system for providing a video file to a wireless telephone.

Galensky does not explicitly show that configured to coordinate downloading of the selected video file such that the user of the wireless telephone is informed when the wireless telephone has insufficient available memory capacity to successfully download the selected video file.

In the same field of endeavor, Abraham teaches configured to coordinate downloading of the selected video file such that the user of the wireless telephone is informed when the wireless telephone has insufficient available memory capacity to successfully download the selected video file (col. 7 lines 35-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, configured to coordinate downloading of the selected video file such that the user of the wireless telephone is informed when the wireless telephone has insufficient available memory capacity to successfully download the selected video file, as taught by Abraham, in order to provide a method and system for optimizing a disc layout containing data files, firmware applications, and multimedia applications so as to minimize seek time between elements on the disc.

Conclusion

8. Any response to this action should be mailed to:

Mail Stop_____ (Explanation, e.g., Amendment or After-final, etc.)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Facsimile responses should be faxed to:

(571) 273-8300

Hand-delivered responses should be brought to:

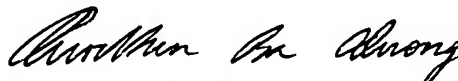
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22313

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571) 272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan Nguyen
Examiner
Art Unit 2618

 8/4/06
QUOCHIEN B. VUONG
PRIMARY EXAMINER